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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/370,488	08/09/1999	MICHAEL A. EPSTEIN	PHA-23.744	8165

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
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EXAMINER

CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/370,488

Applicant(s)

EPSTEIN, MICHAEL A. 

Examiner

Paul E. Callahan

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3^{p.c.} MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 10-13 and 16 is/are rejected.
- 7) ☐ Claim(s) 4, 5, 8, 9, 14, 15 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 1999 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Claims 1-17 are pending in this Application and have been examined.

Response to Arguments

2. Applicant's arguments filed 8-3-2003 have been fully considered but they are not fully persuasive.

The Applicant offers several definitions from Webster's New Collegiate Dictionary and Black's law Dictionary in traverse of the rejections of the claims under 35 USC 11 2nd Paragraph: Indefiniteness. The Examiner notes that such definitions have little if any relevance when used in a scientific or technical context.

However the explanation offered by the Applicant of the use of the term "effects" in claim 3 is sufficient to overcome the rejection of that claim under 35 USC 112 2nd.

The Examiner maintains that the rejection of claim 16 under 35 USC 112 2nd is proper. The phrase "substantially equal to" is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Drawings

2. The explanation offered by the applicant is sufficient to overcome the objections to the drawings found in the previous Office Action.

Response to Arguments

3. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 contains the language of "...the first cryptographic key and the second cryptographic key are substantially equal." It is unclear what is meant by "substantially equal."

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 6, 7 and 11-13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hidaka, US Patent 5,028,919.

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As per claims 1 and 11, Hidaka teaches a remote control device, having a transceiver, that is configured to facilitate control of a plurality of electronic devices each having a transceiver (abstract, fig. 1), comprising: an input device that is configured to accept a user input and provides therefrom a control signal for control of a first device of the plurality of electronic devices (fig. 2), and a receiver that is configured to receive a parameter from a second device of the plurality of electronic devices (fig. 2, col. 1 line 50 through col. 2 line 7), and, a transmitter that is configured to: communicate the parameter from the second device to the first device, and, communicate the control signal to the first device to effect the control of an appliance function of the first device (col. 1 line 50 through col. 2 line 7).

As per claims 2, 7, 12, and 13, Hidaka teaches a remote control device, wherein the receiver is further configured to receive an other parameter from the first device, and the transmitter (transceiver) is further configured to communicate the other parameter from the first device to the second device (col. 1 lines 50 through col. 2 line 7).

As per claim 3, Hidaka teaches a remote control device, further including a controller that effects the communication of the parameter and the other parameter (fig. 1 item 2).

As per claim 6, Hidaka teaches an electronic device comprising: a transceiver that is structured to receive control commands from a remote control device (fig. 1), an appliance apparatus that effects a processing of input information in dependence upon the control commands, a parameter generator that produces a parameter for communication to an other device, and wherein, the

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transceiver is also structured to transmit the parameter, thereby effecting the communication of the parameter to the other device (col. 1 line 50 through col. 2 line 7).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidaka as applied to claim 1 above in view of Official Notice taken as detailed infra.

Hidaka teaches an electronic device, wherein the appliance apparatus includes at least one of: a tuner, a display device, a recording device, and a playback device (fig. 2) but does not mention a set-top box. Official Notice may be taken however that such devices are commonly found in the type of home entertainment system contemplated by Hidaka. Therefore the inclusion of a set-top box in Hidaka is a step that is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included this feature into the system of Hidaka. It would have been desirable to do so as this would increase the marketability of the system.

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Allowable Subject Matter

10. Claims 4, 5, 8, 9, 14, 15, and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claim 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-1336. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse, can be reached on (703) 308-4789. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 Official Faxes, (703) 746-7240 Unofficial Faxes, and (703) 746-7238 After Final Faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

4/24/04

Paul Callahan